

REMARKS

Claims 1-19 are pending in this application. No new matter is added. Claims 1, 16, and 17 are the independent claims.

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Applicant Initiated Interview Summary

The courtesies extended by Examiner Belcher to Applicant's representative, David J. Cho, during a telephonic interview conducted on May 17, 2011, is acknowledged and appreciated. The substance of the interview is set forth in the Examiner's Interview Summary and in the following Applicant Initiated Interview Summary.

As required by 37 C.F.R. § 1.133(b), Applicant's summary of that interview is as follows:

1. Brief Description of any Exhibit Shown

No exhibit was shown or demonstrated during the interview.

2. Identification of the Claims Discussed

The Examiner and Applicant's representative generally discussed independent claims 1 and 16.

3. Identification of the Specific Prior Art Discussed

The Examiner and Applicant's representative discussed U.S. Patent No. 6,691,156 to Drummond et al. and U.S. Patent No. 2002/0120705 to Schiavone et al.

4. Identification of the Proposed Amendments

No amendments were discussed or proposed.

5. Summary of the Arguments Presented to the Examiner

Applicant's representative presented arguments regarding independent claims 1, 16, and 17, are sufficient to overcome the outstanding rejections thereof under 35 U.S.C. § 103(a) over Drummond and Schiavone.

In particular, Applicant's representative presented arguments regarding the failure of the cited prior art references to disclose or suggest, "prioritizing means" which assigns a priority to each of the identification insignias, as taught in claim 1, and similarly taught in independent claims 16 and 17. Examiner Belcher understood Applicant's position and arguments, but requested that Applicant submit a formal response so that he may fully consider and examine the applied references.

6. General Indication of Other Pertinent Matters Discussed

No other pertinent matters were discussed during the interview.

7. General Outcome of the Interview

The Examiner indicated that he understood the arguments advanced by Applicant's representative, and stated that a further review of at least the Schiavone reference would be required before reaching any conclusions as to whether the outstanding rejections based thereon would be withdrawn. The Examiner also indicated that further searching may be required.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 6-9, 11, and 14-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,691,156 ("Drummond") in view of U.S. Patent No. 2002/01200705 ("Schiavone"). Applicant respectfully traverses this rejection for the reasons discussed below.

Applicant respectfully submits that Drummond and Schiavone, individually or in combination, fail to disclose or suggest, will describe or suggest, *inter alia*:

first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message,

second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages,

In the outstanding Office Action, the Examiner admits that Drummond fails to disclose the “first prioritizing means which assignsa first identification insignias of the sender” and the “second prioritizing means...assigns a priority to each of the identification insignias of the senders of the returned messages.”¹ However, the Examiner attempts to remedy the admitted deficiencies of Drummond by asserting that Schiavone discloses the missing features. In particular, the rejection is based on an assertion that Schiavone discloses “first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message” and “second prioritizing means which, in response to recognition of the second message being a reply to the returned message....c.f. page 6, last paragraph in the Office Action. Applicant respectfully disagrees.

Specifically, Applicant respectfully submits that Schiavone is only concerned with **assigning priorities to network paths based on content of a message.**

Schiavone is **not** concerned with assigning of priorities to identification insignias of the senders, and hence does **not** disclose, *among other things*, “second prioritizing means which, in response to recognition of the second message being a reply to the

¹ See Office Action mailed December 14, 2010, page 6, second paragraph.

returned message, assigns a priority to each of the identification insignias of the senders of the returned messages," as recited in claim 1.

In fact, in Schiavone, paragraph [0034], it states:

[t]he message either carries priority information, or is assigned priority information **based on a shared characteristic with other e-mails, such as the message's network path**. The priority information is used to determine how and/or when to deliver the e-mail message. For example, the message may be delayed for a fixed time, or until network/system resource utilization drops to a certain level, etc. or as otherwise prescribed. In this manner, for example, a recipient may choose to have low priority spam messages held for delivery until after his network resource utilization drops to a desired level, or until after all higher priority messages have been delivered, etc. This reduces the burden on the recipient's network/system resources. (*emphasis added*)

Further, Schiavone in paragraph [0023] states:

FIG. 2 is a flow diagram 20 of an exemplary method for using a heuristic approach for identifying a priority level **for an e-mail message's network path** according to the present invention. Accordingly, the method of FIG. 2 may be used as part of step 14 of FIG. 1 when an e-mail message does not carry priority information. Conceptually, the method of FIG. 2 identifies characteristic information that may be shared by multiple messages and performs a statistical analysis on those messages to determine which messages are likely to be from irresponsible senders or be undesirable, etc. , and then assigns all messages having that shared characteristic information a corresponding priority level. (*emphasis added*)

Accordingly, based on above, it is submitted that Schiavone evaluates the content or other characteristics of the message itself to determine a priority which is then assigned to a network path used for delivering the message, whereas the features of claim 1 is directed to "**assigning a priority to the insignia of the sender.**"

Further, in this regard, the term "*insignia*" as described in page 6, third paragraph of the instant disclosure, defines "*insignia*" as:

The simplest form of an insignia is an mail address or the domain part of the sender's email address. More complex insignias can include an email address with or without a list of IP addresses from which a user can send. Alternatively, the insignia may include a domain with or without a list for IP addresses from which the user from that domain can send.

Accordingly, Applicant respectfully submits that the features of claim 1 is related to a priority being assigned to an e-mail address or domain name or similar identification insignia which identifies the sender, rather than a "network path" or other information which is related to the message (rather than to the sender), as taught by Schiavone.

In fact, one skilled in the art would appreciate that Schiavone, which teaches prioritizing a "network path," cannot at all be assigned a priority to an insignia of the sender since it is known that the network path for a specific sender will change constantly. Therefore, the proposed combination of reference of Drummond and Schiavone, would not arrive at the system according to claim 1, where a priority is assigned to each of the identification insignias of the senders of the messages; but rather to a system where the content of the message or the network path by which it was delivered leads to prioritizing the messages. Moreover, Applicant respectfully submits that one of ordinary skill in the art would not have a *reasonable expectation of success* since the prioritization method of the "network path" as taught in Schiavone would render the proposed combination *unworkable*. Therefore, the rejection failed to articulate a proper rationale to support an obviousness rejection.

Accordingly, Applicant respectfully submits that no *prima facie* case of obviousness has been established with respect to amended claim 1.

In view of the above, Applicant respectfully submits that Drummond and Schiavone, individually or in combination, fail to teach or suggest each and every

element of claim 1, and, therefore, claim 1 is allowable over this cited art. Claims 2-4, 6-9, 11, 14, and 15, are dependent from claim 1, and therefore, also allowable.

Claim 16 (and claim 17) is directed to a method claim which corresponds to claim 1. Applicant respectfully submits that this claim is also allowable for the similar reasons presented above in regard to amended claim 1.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 5, 10, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Schiavone in view of U.S. Patent Application Publication No. 2004/0205127 ("Ben-Yosef"). Applicant respectfully traverses this rejection for the reasons discussed below.

Claims 5, 10, and 13 are believed to be allowable for at least the reasons set forth above regarding claim 1. Ben-Yosef fails to provide the teachings noted above as missing from Drummond and Schiavone. Since claims 5, 10, and 13 are patentably at least by virtue of their dependency on claim 1, Applicant respectfully requests that the rejection of claims 5, 10, and 13 under 35 U.S.C. § 103(a) be withdrawn.

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Schiavone and Ben-Yoseph in view of U.S. Patent No. 6,330,590 ("Cotten"). Applicant respectfully traverses this rejection for the reasons discussed below.

Claim 12 is believed to be allowable for at least the reasons set forth above regarding claim 1. Cotten fails to provide the teachings noted above as missing from

Drummond and Schiavone. Since Claim 12 is patentably at least by virtue of its dependency on claim 1, Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above remarks and amendments, Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicant does not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant hereby petitions for a three (3) month extension of time for filing a reply to the outstanding Office Action and submit the required extension fees herewith.

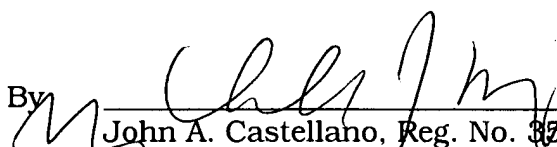
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By

 434,313
John A. Castellano, Reg. No. 35,094

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

JHA
JAC/DJC:has
1191350.1